

## **REMARKS**

In response to the Office Action mailed June 29, 2005 ("the 6/29/2005 Office Action"), claims 43, 61, and 80 are currently amended; no claims are added or cancelled. Consequently, claims 43-87 are all of the claims currently pending in the application. Applicants thank the Examiner for indicating that claims 55-57, 70, and 71 include allowable subject matter, and that these claims would be allowable if rewritten in independent form. However, Applicants decline to rewrite claims 55-57, 70, and 71 in independent form at the present time. In light of the amendments and remarks presented in this paper, allowance of all the claim currently pending in the application is respectfully requested.

### *Finality of the 6/29/2005 Office Action*

The Examiner asserts that the finality of the 6/29/2005 Office Action is in compliance with MPEP § 609(B)(2)(i). However, the Examiner bases this assertion on the false premise that Applicants submitted an Information Disclosure Statement ("IDS") on 3/17/05 with the fee set forth in 37 CFR 1.17(p). *See* the 6/29/2005 Office Action at page 6. Since this is not true, and Applicants in fact did not file the IDS with the fee set forth in 37 CFR 1.17(p), but instead complied with 37 CFR 1.97(c) by filing the IDS with a statement under 1.97(e), the finality of the Office action is improper and should be withdrawn. Accordingly, prosecution of the instant application should be reopened, and the amendments presented in this paper should be entered.

### *Rejections Under 35 U.S.C. § 102*

Claims 43-46, 51, 54, 80, and 81 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by UK Patent Application GB 2 175 835 to Coughtrie ("Coughtrie"). Although applicants disagree with the rejection, claims 43 and 80 have been amended to

emphasize various distinctions between the invention and Coughtrie. In light of these amendments, the rejection of claims 43-46, 51, 54, 80, and 81 should be withdrawn *at least* because Coughtrie does not disclose all of the features of the claimed invention.

More particularly, independent claim 43 has been amended to recite, *inter alia*, “wherein the backing portion of each of the blade members contains a relatively lower amount of carbon in comparison with the amount of carbon in the cutting edge portion of the blade members.” Independent claim 80 has been amended to recite, among other things, “the workpiece engaging structure comprising a workpiece engaging portion containing a relatively lower amount of carbon and a backing portion containing a relatively lower amount of carbon.” Coughtrie appears to disclose jaws that are welded to handles of pliers. *See* Coughtrie at the Abstract. However, Coughtrie does not disclose any elements with portions containing different amounts of carbon. For at least this reason, the rejection of claims 43 and 80 should be withdrawn. Further, claims 44-46, 51, 54, and 81 depend from corresponding ones of 43 and 80, and therefore, are allowable over Coughtrie based on their dependency as well as for the features they add to the independent claims.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 47-50, 58-66, 72-79, 82, and 85-87 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Coughtrie in view of U.S. Patent No. 1,373,555 to Graham. Applicants disagree with these rejections at least because Coughtrie and Graham do not teach or suggest all of the features of the claimed invention.

##### **A. Claims 47-50, 58-66, 72-74, 82, and 85-87**

Independent claim 61 has been amended to recite, *inter alia*, “wherein a first portion of each of the blade members contains a relatively lower amount of carbon and a second portion of each of the blade members contains a relatively higher amount of carbon.”

Independent claims 85-87 have been amended to recite "wherein the cutting edge portions contain a relatively lower amount of carbon and other portions of the blade members contain a relatively higher amount of carbon," among other things. As was discussed above with respect to independent claims 43 and 80, Coughtrie is deficient at least for failing to teach or suggest these features. Similarly, Graham is also silent with respect to this subject matter. For at least this reason, the rejection of independent claims 61 and 85-87 should be withdrawn. Further, claims 47-50, 58-60, 62-66, 72-74, and 82 depend from corresponding ones of independent claims 43, 61, and 80, and therefore, are allowable over Coughtrie and Graham based on their dependency as well as for the features that they add to the independent claims.

B. Claims 75-79

Independent claim 75 recites, *inter alia*, "welding a blade member to the jaw portion of each elongated member by (a) placing the jaw portions of the tool body in their closed position, (b) positioning the blade members such that each blade member is in contact with each projection on a respective jaw portion, and (c) applying electrical current and force to the tool body and the blade members, the electrical current being applied utilizing a first electrode in contact with the blade members and a second electrode in contact with the tool body, the applied electrical current flowing through each projection and the associated blade member and establishing a sufficient current density in each projection to cause the metallic material of each projection to soften and the force being applied utilizing the first electrode, the first electrode being configured and operable to move each blade member and metallic material from each projection toward the associated jaw portion thereby forming a welded connection between each blade member and a respective jaw portion of the tool body and to align the cutting edges of the blade members with one another as each welded connection is

formed so that when the jaw portions are in their closed position, the cutting edges of the blade members are aligned with one another."

The Examiner acknowledges that Coughtrie fails to teach or suggest assembling the blade while the elongated members are in a closed position. Graham, the Examiner asserts, teaches "assembling a blade to elongated members so as to be in abutting relation when the members are in a closed position, which is capable of being performed while the members are in a closed position." The 6/29/2005 Office Action at page 4. This rejection is improper because whether or not the tool described in Graham could have been manufactured according to the claimed method is not material to the patentability of the claimed method. Thus, the rejection of claim 75 should be withdrawn because neither Graham nor Coughtrie teach a method in which a blade is assembled to an elongated member in a closed position. Further, claims 76-79 depend from claim 75, and therefore are allowable over Coughtrie and Graham based on their dependency as well as for the features that they add to claim 75.

#### ***Conclusion***

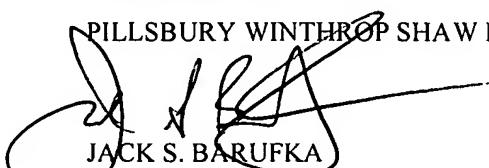
All rejection and objections have been addressed. The present application is now in condition for allowance, and a Notice to that effect is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Should there by any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



JACK S. BARUFKA

Reg. No. 37,087

Tel. No.: 703.905.2012

Fax No.: 703.905.2500

P.O. Box 10500  
McLean, VA 22102  
(703) 905-2000